

JC10 Rec'd PCT/PTO 27 APR 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#6

In re application of:

Hubertus Johannes Marie OP DEN CAMP, et al.

Serial. No. 10/500,872

Filed: July 7, 2004

For: FERMENTATION OF PENTOSE SUGARS

Art Unit: TBA

Examiner: TBA

Confirmation No.: 1317

Atty. Docket No. 28902.0008

Customer No. 30827

Mailstop PCT

Commissioner of Patents

Office of PCT Legal Administration

P.O. Box 1450

Alexandria, VA 22313-1450

COMMUNICATION: CORRECTION OF INVENTORSHIP

Dear Sir:

In response to the Decision mailed March 3, 2005, Applicants respectfully submit:

- Statement of Facts in Support of Petition to Correct Inventorship;
- Consent of Assignee Royal Nedalco B.V. under 37 CFR §3.73(b); and
- Copy of Decision

In light of the foregoing, Applicants request that the Commissioner grant the Petition filed December 6, 2004. This application is deemed to be in proper condition for examination and such favorable action is earnestly solicited.

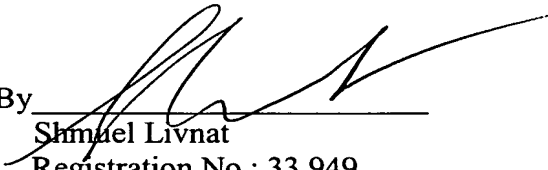
If any additional fees are required to complete the filing of this response, this is to serve as authorization for the extra fees to be charged to Deposit Account No. 50-0911.

Please also credit any overpayment to Deposit Account No. 50-0911.

Respectfully submitted,

Dated: April 27, 2005

By


Shmuel Livnat

Registration No.: 33,949

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03 MAR 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
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McKenna Long & Aldridge LLP
1900 K Street, NW
Washington, D.C. 20006

In re Application of
OP DEN CAMP et al.
Application No.: 10/500,872
PCT No.: PCT/NL03/00049
Int. Filing Date: 23 January 2003
Priority Date: 23 January 2002
Attorney Docket No.: 28902.0008
For: FERMENTATION OF PENTOSE
SUGARS

3197.NOB-8
(28902.0008)
SZL

RECEIVED
MAR 04 '05
DATE DOCKETED: 3/4/05
DOCKETED BY: [Signature]
DECISION: 5/3/05 REQUEST
UNDER 37 CFR 1.497(d)
FINAL DATE: 4/3/05
ATTORNEY CONFIRMATION:
McKENNA LONG & ALDRIDGE

This decision is in response to "Petition to Correct Inventorship under 37 CFR 1.48(a)" filed 06 December 2004, which is being treated as a petition under 37 CFR 1.497(d). The \$130 petition fee under 37 CFR 1.17 has been submitted.

BACKGROUND

On 23 January 2003, applicants filed the above-captioned international application, which claimed a priority date of 23 January 2002. The international application named Hubertus Johannes Marie Op Den Camp; Harry Ramanoedj; and Christiaan Van der Drift as applicant/inventors. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 23 July 2004.

On 07 July 2004, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a basic national fee; a translation of the international application; and a declaration executed by: Hubertus Johannes Marie Op Den Camp; Harry Ramanoedj; Christiaan Van der Drift and Jacobus Thomas Pronk.

On 04 October 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration filed 07 July 2004 was defective because the declaration sets forth an inventor who had not been named in the international application. Furthermore, the Notification stated that a sequence listing in computer readable form had not been submitted as required by 37 CFR 1.821-1.825. The notification set a two-month time limit in which to respond.

On 06 December 2004, applicants filed "Petition to Correct Inventorship under 37 CFR 1.48(a).

DISCUSSION

In the instant case, the international application named Hubertus Johannes Marie Op Den Camp; Harry Ramanoedj; and Christiaan Van der Drift as applicant/inventors. Applicants request to add Jacobus Thomas Pronk as an applicant/inventor. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a submission under 37 CFR 1.497(d) is required.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires: (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part; (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a); (3) the fee set forth in 37 CFR 1.17; and (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b). Applicants have satisfied items (2) and (3).

Regarding item (1), applicants have not provided a statement from Jacobus Thomas Pronk which states that the error in inventorship occurred without deceptive intent.

Applicants have not satisfied (4). In order to satisfy item (4), applicants are required to submit a written consent of assignee to the correction in inventorship in compliance with 37 CFR 3.73(b), or written confirmation that no assignee exists. Here, the international application indicates Royal Nedalco B.V. as an applicant and it is unclear if the invention has been assigned to Royal Nedalco B.V.

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is DISMISSED without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. A proper response must include a statement from Jacobus Thomas Pronk and a written consent of assignee in compliance with 37 CFR 3.73(b). Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Hubertus Johannes Marie OP DEN CAMP, et al.

Customer No.: 30827

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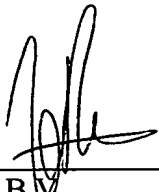
CONSENT OF ASSIGNEE ROYAL NEDALCO B.V. UNDER 37 CFR § 3.73(b)
FOR CORRECTION OF INVENTORSHIP


Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Royal Nedalco B.V. is the assignee of the entire right, title and interest in the above-referenced U.S. patent application. I am authorized to act on behalf of the Assignee and agree to correct the inventorship of the above-referenced U.S. patent application to add Jacobus Thomas PRONK as an inventor.

Attached is a copy of the Assignment document executed by all four of the inventors and Assignment Recordation request, filed in the U.S. Patent and Trademark Office on 25 March 2005.

J.J.J. den Ridder  Date 8-4-2005
Royal Nedalco B.V.

M.J.N. Schel  8-4-2005



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

H.J.M. OP DEN CAMP, *et al.*

Serial No.: 10/500,872

Based on Int'l App. PCT/NL03/00049

Filing Date: July 7, 2004

For: FERMENTATION OF PENTOSE SUGARS

Examiner: *unassigned*

Art Unit: *unassigned*

Atty Dkt No: 28902.0008

Customer No. 30827

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**STATEMENT OF FACTS IN SUPPORT OF
PETITION TO CORRECT INVENTORSHIP**

Sir:

I, the undersigned, Jacobus Thomas Pronk, hereby state as follows:


1. I am a co-inventor of the invention claimed in the above-identified application.
2. I am professor of Industrial Microbiology at the Technical University of Delft in the Netherlands and acted as advisor to Bird Engineering, a research and consultancy company that has a consultancy agreement with Royal Nedalco B.V. ("Nedalco"). Through that agreement, I have advised Nedalco on the technology of ethanol production.
2. I invented the expression of the xylose isomerase gene in yeast and executed a Declaration for the above-identified U.S. patent application on 30 June 2004. This Declaration, according to the U.S. attorney handling the case, was filed in the U.S. Patent and Trademark Office (USPTO) on 06 December 2004, along with a Petition to Correct Inventorship.
3. I have assigned my rights in the invention to Nedalco by executing an Assignment of the U.S. application on 30 June 2004. According to the U.S. attorney handling the case, this Assignment was filed for recordation in the USPTO on 25 March 2004.
4. My name was inadvertently omitted from the PCT application. I was unaware of this omission which I understand occurred due to inadequate communication between the PCT Applicant (and U.S. assignee) Nedalco and their Dutch patent attorney, Dr. Bart Swinkels.

5. On information and belief, once this omission occurred, Dr. Swinkels acted expeditiously to inform the U.S. attorney of the error and to begin the process of correcting the inventorship.

6. The omission of my name as an inventor occurred as an inadvertent error, without any deceptive intent on my part. On information and belief, the omission occurred as an error without any deceptive intent on the part of the originally named inventors, the assignee Nedalco and the attorney preparing the PCT application, Dr. Swinkels.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Dated: April 7 2005

By 
Dr. Jacobus Thomas Pronk